

Art Unit: 1795

This is in response to Appeal Brief filed on 10/20/09.

I. Appeal Brief filed on 10/20/09 is nonresponsive because the record is incomplete. The record shows that applicant fails to try to overcome the issue of the double patenting rejection of the claims on the record by either (1) properly and timely filing a terminal disclaimer in order for an expert to timely check and approve before an allowance is considered and indicated or (2) properly and timely provide an argument for a proper and timely consideration for an early allowance of the claims.

II. The exhibits or evidences of:

$$1 \text{ wt\% TMAH}$$

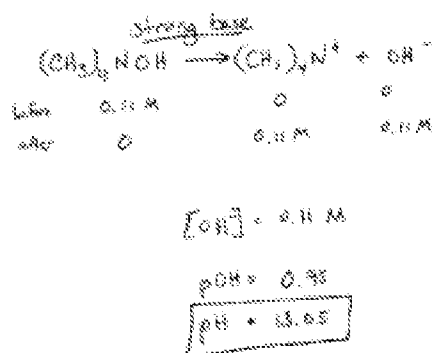
$$\text{assume } 100 \text{ g of solution}$$

$$\frac{1 \text{ g TMAH}}{99 \text{ g}} = 0.011 \text{ wt\% TMAH}$$

$$\text{assume density of } 1 \text{ wt\% TMAH} = 1 \text{ g/mL}$$

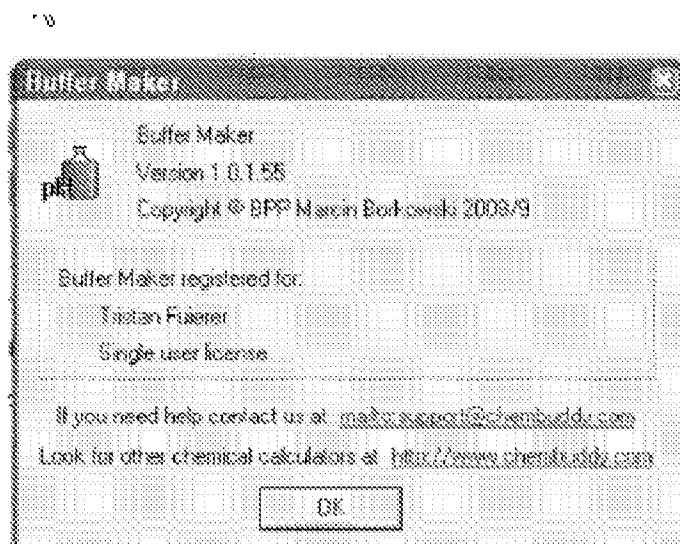
$$\frac{100 \text{ g } 1 \text{ wt\% TMAH}}{1 \text{ g}} = 100 \text{ mL}$$

$$\text{Molarity TMAH} = \frac{0.011 \text{ moles}}{0.1 \text{ L}} = 0.11 \text{ M}$$



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on page 9;



on page 10;

pH = 8.00

at temperature 25 °C

lactic acid 0.05M

l-lactic acid = 0.05 M (total)

buffer strength = 0.05000

Prepared by

Thursday, August 27, 2009

To make 1 L of above solution mix:

90.00 mL of 1.000M lactic acid

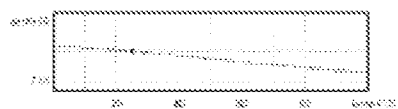
10.00 mL of 1.000M NaOH (25%QW)

Fill up to 1 L

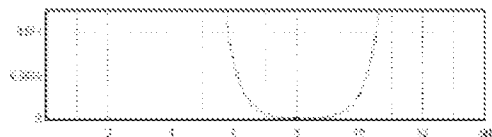
If preparing by titration @ 25 °C, titrate to pH = 8.00

Remember to check and - if necessary - adjust pH of your buffer!

Buffer pH vs temperature plot:



Buffer capacity vs pH plot:



Equation to angle:

along along temperature axis:

10 mmoles, pH = 8.30

5 mmoles, pH = 8.71

2 mmoles, pH = 9.04

neutral lactic acid, pH = 9.38

along along concentration axis:

1 mmoles, pH = 10.00

2 mmoles, pH = 11.00

10 mmoles, pH = 12.00

pH = 9.00

at temperature 25 °C

lactic acid 0.05M

l-lactic acid = 0.05 M (total)

buffer strength = 0.05000

Prepared by

Thursday, August 27, 2009

To make 1 L of above solution mix:

90.00 mL of 1.000M lactic acid and 10.00 mL of 1.000M NaOH (25%QW)

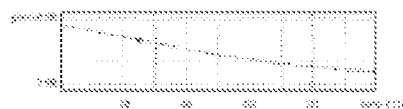
10.00 mL of 1.000M NaOH (25%QW)

Fill up to 1 L

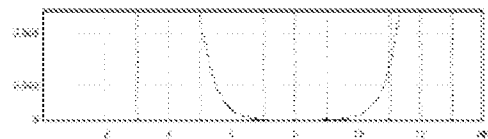
If preparing by titration @ 25 °C, titrate to pH = 9.00

Remember to check and - if necessary - adjust pH of your buffer!

Buffer pH vs temperature plot:



Buffer capacity vs pH plot:



Equation to angle:

along along temperature axis:

10 mmoles, pH = 9.38

5 mmoles, pH = 9.71

2 mmoles, pH = 10.04

neutral lactic acid, pH = 10.38

along along concentration axis:

1 mmoles, pH = 11.00

2 mmoles, pH = 12.00

10 mmoles, pH = 13.00

on page 11 and

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pH = 10.00

at temperature 25 °C

buffer acid=THAM

Concentration = 0.05 M (total)

ionic strength = 0.05000

Prepared by:

Thursday, August 27, 2009

To make 1 L of above solution mix:

50.00 mL of 1.0000M acetic acid (pKa=4.75)

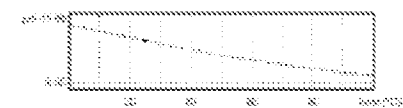
80.13 mL of 1.0000M Tris-HCl (pKa=8.07)

Fill up to 1 L

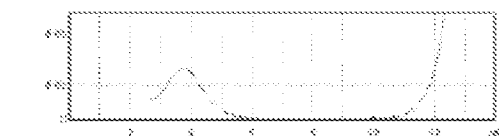
If preparing by titration @ 25 °C, titrate to pH = 10.00

Remember to check and - if necessary - adjust pH of your buffer!

Buffer pH vs temperature plot



Buffer capacity vs pH plot



Expected pH changes

adding strong mineralic acid

0.0000L, pH = 10.00

5.0000L, pH = 9.75

1.0000L, pH = 9.50

10.0000L, pH = 9.25

adding strong mineralic base

1.0000L, pH = 9.25

5.0000L, pH = 9.00

10.0000L, pH = 8.75

pH = 11.00

at temperature 25 °C

buffer acid=THAM

Concentration = 0.05 M (total)

ionic strength = 0.05000

Prepared by:

Thursday, August 27, 2009

To make 1 L of above solution mix:

50.00 mL of 1.0000M acetic acid (pKa=4.75)

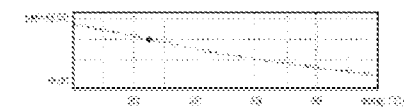
80.29 mL of 1.0000M Tris-HCl (pKa=8.07)

Fill up to 1 L

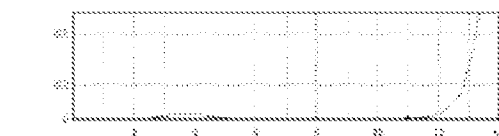
If preparing by titration @ 25 °C, titrate to pH = 11.00

Remember to check and - if necessary - adjust pH of your buffer!

Buffer pH vs temperature plot



Buffer capacity vs pH plot



Expected pH changes

adding strong mineralic acid

0.0000L, pH = 11.00

5.0000L, pH = 10.75

1.0000L, pH = 10.50

10.0000L, pH = 10.25

adding strong mineralic base

1.0000L, pH = 10.25

5.0000L, pH = 10.00

10.0000L, pH = 9.75

On page 12 must be properly listed under “Evidence Appendix”.

III. Evidences on pages 11 and 12 are mostly unreadable. Accordingly, readable evidences must be provided for a full, complete and proper consideration.

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IV. Applicant is given one time of one month only from the date of receiving this Office Action to file a new, readable, proper, full and complete appeal brief (when there is no terminal disclaimer being filed prior to or at the same time with filing of the new brief) without paying a fee. Otherwise, an extension of time will be calculated and charged. In this case, a proper fee payment must be on the record before considering of the newly filed appeal brief. After six months from receiving date of this Office Action, A note of abandonment will be sent to applicant. It is now, timely and clearly pointed out and set forth the record.

V. On 11/12/09, the issues in this Office Action have been presented, discussed and authorized by Supervisors and Specialists Jill A. Warden (571-272-1267) and Patrick J. Ryan (571-272-1292).

VI. There have been two rejections in the Final Office Action on the record mailed on 02/24/09 prior to Appeal Briefs being filed as:

(1). The statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed.

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Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4-6, 10, 15, 17-21, 53 and 56 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-6, 12-17, 33-36, 39, 42-47 as amended on 01/10/08 of copending Application No. 10/389,214 (and its teachings and suggestions in the specification on at least paragraphs 9, 12, 13, 17, 18, 21, 23, Examples 2, 4 and 5. However, applicants, assignee and their counsel may and should disagree, urge and state on and for the record that each of the claims as originally filed is self sufficient. There has not been and will not be relied on any embodiment and any application for any purpose) considered in view of En et al ((2004/0134682) as a secondary reference).

Applicants in the applied broad claims with “comprising” and the broad teachings and/or suggestion in their specification are related to a cleaning composition containing chemical ingredients and their amounts as those in the

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instant claims. But, applicants in the applied broad claims with “comprising” and the broad teachings and/or suggestion do not specify an alkali base.

However, it is known in the art at the time the invention was made to obtain and use an alkali base for the advantage of providing a sufficient alkalinity and stripping power. Evidence can be seen in at least En et al at paragraph 0550, 0600, 0612, 0620, 0653, 0714, 0754 and 0774.

Since the above references are all related to cleaners, stripper and/or removers, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite potassium hydroxide alkaline agent for a reasonable expectation of sufficiently providing an additional alkalinity and stripping power to one having ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

(2). The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-2, 4-5, 10, 15, 19-20 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koito et al (2003/0130147) considered in view of En et al (2004/0134682) or Sato et al (5,849,467).

Koito et al disclose, teach and suggest a cleaning (stripping and removing) composition of an unwanted material. The composition comprises a quaternary base and adenine. Please see the whole disclosure, especially on paragraphs 0031, 0045, 0077, 0085.

Koito et al do not specify an alkali base. However, it is known in the art at the time the invention was made to obtain and use an alkali base for the advantage of providing a sufficient alkalinity and stripping power. Evidence can be seen in at least En et al at paragraph 0550, 0600, 0612, 0620, 0653, 0714, 0754 and 0774 or in Sato et al on at least on col.3:52 to 4:61, 5:41-48, 7:34-48, Examples 1, 5 and 8.

Since the above references are all related to cleaners, removers and/or strippers, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite potassium hydroxide alkaline agent for a reasonable expectation of sufficiently providing an additional alkalinity and stripping power to one having ordinary skill in the art.

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The above rejections are reproduced as the reminders but not new or reopen the prosecution.

VII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached on 6:30AM-5:00PM, M-TH.

If attempts to reach the examiner by telephone are unsuccessful, one of the supervisors: Mark Huff can be reached on 571-272-1385 and Supervisors and Specialists Jill A. Warden (571-272-1267) and Patrick J. Ryan (571-272-1292). The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hoa V. Le/

Primary Examiner, Art Unit 1795

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